

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MITSUYASU MAKITA and
TADAHIRO MATSUNAGA

Appeal No. 2001-1286
Application No. 09/263,795

ON BRIEF

Before WINTERS, ADAMS, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 16, which are all of the claims pending in the application.

Representative Claim

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A pest repellent composition comprising an effective pest repelling amount of carane-3,4-diol as an ingredient, a non-porous round polyethylene powder, and a solvent. [Emphasis added]

The Prior Art Reference

The examiner relies on the following prior art reference:

Shono et al. (Shono)	5,130,136	Jul. 14, 1992
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The Rejection

Claims 1 through 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Shono.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Brief (Paper No. 9); (3) the Examiner's Answer (Paper No. 10); and (4) the above-cited prior art reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection.

Discussion

Initially, we note that an oral hearing had been scheduled in this appeal for April 9, 2002. On reflection, however, this merits panel decided that a hearing was not necessary and so notified the applicants (Paper No. 14). See 37 CFR § 1.194(c).

Each independent claim on appeal requires "a non-porous round polyethylene powder." Having reviewed the Shono Patent in its entirety, we find that Shono does not

constitute sufficient evidence to support a conclusion of obviousness of claims containing that limitation.

We shall not belabor the record with extensive comment in this case.

Shono discloses an insect repellent composition comprising an effective amount of carane-3,4-diol, as active ingredient and a solvent. Shono further discloses that

The present compositions formulated as described above . . . can be used by a method comprising applying them to a suitable sheet-form, film-form, net-form or band-form base material by treatment such as coating, impregnation, kneading, dropping, etc., and putting the repellent-applied base material directly onto exposed area of the skin or onto the clothing. [Column 5, lines 39 through 47]

The base material may be, e.g., a synthetic resin such as polyethylene. When a net-form base material is used, that of a finer mesh is more preferable. Generally, however, a size of about 16 or finer mesh is sufficiently effective (Shono, column 5, lines 48 through 57). Simply stated, Shono would not have led a person having ordinary skill in the art from “here to there,” i.e., from a suitable sheet-form, film-form, net-form, or band-form base material to “a non-porous round polyethylene powder” recited in each claim on appeal. For the reasons succinctly set forth in applicants’ Appeal Brief (Paper No. 9), pages 12 through 15, we conclude that the examiner failed to establish a prima facie case of obviousness of claims 1 through 16.

Having determined that the examiner failed to establish a prima facie case of obviousness, we find it unnecessary to discuss objective evidence of non-obviousness in applicants’ specification which is relied on to rebut any such prima facie case.

The examiner's decision is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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Appeal No. 2001-1286
Application No. 09/263,795

Page 5

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